

I. § 102 Rejection

Claims 1-10, 17-19, and 25-28 stand rejected under 35 U.S.C. § 102(a) as being anticipated by Seed (World Patent Application No. 96/09378). Applicants respectfully traverse this rejection.

In order for a reference to constitute prior art under § 102(a) it must be "by others." M.P.E.P. § 2132. The instant application names Dr. Brian Seed and Dr. Jurgen Haas as co-inventors. Since WO 96/09378 lists only Dr. Brian Seed as an inventor, the Examiner asserts that the inventive entity of the instant application is different from the WO document.

Despite the omission of Dr. Haas from the list of inventors on the first page, WO 96/09378 is not a publication "by others," because Dr. Haas was, in fact, an inventor and should have been listed on the publication. Thus, the information concerning inventorship provided on the face of the WO document is incomplete and does not accurately reflect Dr. Haas's contribution.

In support of this assertion, Applicants note that the PTO has, in effect, acknowledged that Dr. Haas was an inventor of WO 96/09378. WO 96/09378 is the foreign counterpart of U.S. Patent No. 5,786,464 ("the '464 Patent"). WO 96/09378 claims priority from U.S.S.N. 08/324,243, the application that matured into the '464 Patent. The specification of the '464 Patent is the same as WO 96/09378. Furthermore, the claims of WO 96/09378 are identical to the claims of U.S.S.N. 08/324,243 as

originally filed. Although the '464 Patent issued naming only Dr. Seed as an inventor, the PTO granted a petition to correct inventorship adding Dr. Haas as an inventor. (A copy of the Certificate acknowledging the correct inventorship of the '464 Patent is attached hereto as Exhibit A). Thus, by acknowledging that Drs. Seed and Haas were both inventors of the '464 Patent, the PTO has also, in effect, acknowledged that they were both inventors of its foreign counterpart, WO 96/09378, especially given that there is no material difference between the two documents. Therefore, WO 96/09378 cannot be used as 102(a) prior art against Drs. Seed and Haas because it is not a publication "by others."

In an attempt to simply and clarify matters, Applicants filed a request with the International Bureau of WIPO asking that the first page of WO 96/09378 be republished listing both Drs. Seed and Haas as inventors. Unfortunately, the International Bureau did not record the requested change because, at the time the request was made, the deadline for recording inventorship changes had expired. See PCT Rule 92bis. Although it may have clarified matters if the International Bureau had recorded the change in inventorship, Applicants nevertheless submit that republication of WO 96/09378 is not necessary since, as explained above, the PTO has already recognized that Dr. Haas was an inventor of WO 96/09378. The § 102(a) rejection should, therefore, be withdrawn.

## II. Double Patenting Rejection

Claims 1-4, 6-10, 18, and 28 stand rejected under the judicially created doctrine of double patenting over claims 1-4, 6-9, 11, 15, and 17 of U.S. Patent No. 5,786,464.

Applicants have filed herewith a terminal disclaimer that disclaims any portion of the present patent term that extends beyond the expiration date of the '464 Patent. The filing of this disclaimer is not an acquiescence or admission of any kind by Applicants concerning the obviousness of this or any other related invention. It does, however, obviate the double patenting rejection, and this rejection may be withdrawn.

## III. Objection to Claim 20

Claim 20 has been objected to as being dependent upon a rejected base claim. Claim 20 depends from claim 18, which in turn depends from claim 17, which in turn depends from claim 1. Although claims 1, 17, and 18 all stand rejected, Applicants have demonstrated above that the rejections of these claims should be withdrawn. Applicants, therefore, submit that claim 20 may properly remain in dependent form, and this objection should be withdrawn.

## IV. Conclusion

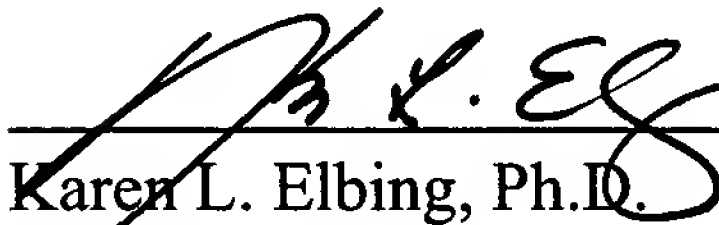
In light of the foregoing amendments and remarks, Applicants submit that the claims are now in condition for allowance, and such action is respectfully requested.

If there are any charges, or any credits, please apply them to Deposit Account No.

03-2095.

Respectfully submitted,

Date: 11 January 2000

  
\_\_\_\_\_  
Karen L. Elbing, Ph.D.  
Reg. No. 35,238

Clark & Elbing LLP  
176 Federal Street  
Boston, MA 02110  
Telephone: 617-428-0200  
Facsimile: 617-428-7045

\\Ceserver\documents\00786\345xxx\00786.345001 Response to Office Action mailed 10-15-99.wpd